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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/099,966	03/19/2002	Hiromi Ukai	62807-015	7234

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McDermott, Will & Emery
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Washington, DC 20005-3096

EXAMINER

CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
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3622

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/099,966	Applicant(s) UKAI ET AL.	
	Examiner Jeffrey D. Carlson	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11,15,31,34,35,37,38 and 40-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11,15,31,34,35,37,38 and 40-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the paper(s) filed 4/25/2008.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 11, 15, 31, 34, 35, 37, 38, 40-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spector in view of Landesmann (US20030158776) further in view of Kitsukawa et al (US6282713).**

Regarding claims 11, 15, Spector teaches a user's TV receiving device that receives broadcasted/transmitted television content including a commercial. The customer is given the chance to request a coupon for the product offered in the commercial and he may make such a request using the remote control [para 32]. The presence of the commercial itself represents coupon information that a coupon request can be made. The request includes an identification of the product, viewer profile information and timing information and what specific commercial was being shown at the time [para 16, 22, 30, 33]. A coupon is then retrieved from coupon storage and issued based on the request [37]. A central host computer also monitors the number of coupon responses (requests) and redemptions in order to manage and nimbly makes changes to the coupon campaign operations [para 23, 24, 34, 35, 39]. The steps of reactively modifying a particular

product's coupon campaign based upon collected coupon usage (responses and redemptions) inherently provides a calculation regarding the number of issuances and redemptions for that product/commercial's coupons. As the coupon requests are tied to a specifically identified product commercial (using embedded identification information), it can be said that Spector calculates a number of issued coupons for the commercial message on the basis of the extracted identifier. Regarding the "determining a period, number of times or a fee, for the broadcasting or transmitting of the program or commercial message", the ability to calculate a number of issuances of coupons inherently provides a number of minimum times that the corresponding commercial was broadcasted and/or viewed, therefore meeting this limitation. Spector does not teach how advertisers are charged for their advertising. **Landesmann** teaches electronic advertising deliverable through interactive television where advertisers can be charged based on number of messages delivered, or number of consumer actions" such as clicks on banners (i.e. requests), redeemed coupons, number of purchases [0156]. This dynamic fee system enables advertisers to pay for advertising that is providing value to the advertiser (i.e. action are taken by interested users) rather than merely paying for advertising delivered that may not actually be seen by users or may simply be advertising that is ignored by users. It would have been obvious to one of ordinary skill at the time of the invention to have billed the advertisers of Spector in such a manner. **Kitsukawa et al** also teaches delivery of electronic coupons to users via broadcast television content. Kitsukawa et al teaches that the user can be notified of the availability of a coupon, that the user can select the coupon and that the system will store information concerning the broadcasted content when the coupons were delivered - program title, program description, air date/time and

channel [11:48-54]. Upon redemption, this data is accessed and the central host includes storage of these coupon identifiers along with the broadcast content information [12:9-20] to allow for “statistical television data.” It would have been obvious to one of ordinary skill at the time of the invention for Spector to have included this data with the coupon request to that coupon requests as well as redemptions can be tied to particular advertisements and that advertisers can be charged accordingly for the user “actions” associated with their coupons and associated broadcasted commercials/programs. While Spector includes a relay server that inserts additional information about the user and the originating program, the user receivers or Spector must inherently have some sort of show coding/identification of the channel, name, date/time so that the relay server can know what added metadata/details to insert. It would have been obvious to one of ordinary skill at the time of the invention to have the user’s receiver attach this (ultimately necessary) information to the initial coupon request. First, the user’s receiver (PVR) already inherently includes all the needed information concerning the details of the broadcast (time, channel, program name). Second, the receiver (PVR) can play shows recorded earlier and in this case, the recorder must specify to the relay server what particular broadcast time, date, channel are associated as the originating commercial. Third, where this information is attached is not taken to be critical to the instant invention as applicant himself states that the information can be attached by the receiver or by another entity [see PG PUB para 0030]. What is clear to one of ordinary skill when reading the applied references is that in order for the invention to operate, the information must be provided at some point prior to issuing the coupon so that the association with the particular broadcast can be captured. Given the above teachings of Kitsukawa et al, it would have been obvious to one of ordinary skill at

the time of the invention to modified Spector to collect and analyze the TV programming data which acted as a source of the requested or issued coupons so that marketing decision makers can better understand the TV programming, TV audience behavior, and their participation in the coupon campaign, in order to optimize future coupon campaigns. It would have been obvious to one of ordinary skill at the time of the invention to have collected statistical television data as suggested by Kitsukawa et al in order to determine the relative success of the coupons (number of requests, number of redemptions, elapsed time before redemption) for each of the associated broadcasts in order to provide basic Marketing insight, especially as Spector notes desires for demographic and regional analysis and applicant has indicated that audience rate of a broadcast program has conventionally been used [spec page 2 lines 10-12]. Regarding the EPG (eletronci program guide), Kitsukawa et al teaches that program content is classified (i.e. identified) by the receiver's electronic program guide (EPG) [col 5 lines 32-35]. It would have been obvious to one of ordinary skill at the time of the invention to have used such identification data in order to notify the host of the program being watched in association with the requested coupon in order to enable the statistical analysis of uniquely identified coupons and related programming as desired by Kitsukawa et al.

Regarding claims 31, 35, 38, 40, 42, 44, Spector teaches that demographic profile information is sent as part of the request [para 22, 30, 33] and that this demographic profile information is used to target the coupon. Spector also mentions that it is known to analyze television-delivered coupons to determine usage of the coupons and the demographics of usage [0013]. Spector also teaches that coupons requested via the television system can be analyzed according to how the product is selling in a particular area or to a defined

consumer group/segment. Spector however does not specifically teach gender or age. However, Official Notice is taken that it is well known to collect demographic information (including gender, age and other characteristics) about coupon users (as well as television viewers) in order to provide insight to the coupon (and TV) behavior of various demographic segments. It would have been obvious to one of ordinary skill at the time of the invention to have determined the coupon and/or TV behavior of various demographically-segmented users' according to their regions (obvious that time zone of program can define a region) of Spector in order to use the gained knowledge for better marketing decisions when dealing with these groups of consumers. Regarding the times of the issuances and redemptions, Spector teaches that the coupon offers are short life coupons which indicates the need to calculate redemption-issue times to verify the validity of the short-life coupon. Further, the dynamic nature of Spector's system that adapts according to recent coupon issuances and redemptions inherently requires time/date-indications of the coupons' issuances and redemptions.

Regarding claims 34, 37, 41, 43, Landesmann teaches that a coupon campaign may include a threshold specifying the number of advertisements to be issued overall [0156]. It would have been obvious to one of ordinary skill at the time of the invention to have provided such a limit with that of Spector so that the provider of the advertised coupons does not over-extend his campaign offers.

4. Claims 34, 37, 41, 43 are alternately rejected under 35 U.S.C. 103(a) as being unpatentable over Spector, Landesmann (US20030158776) and Kitsukawa et al (US6282713) as above and further in view of Lemon et al (US4674041).

Regarding claims 34, 37, 41, 43, Lemon et al teaches that a coupon campaign may include a threshold specifying the number of coupons to be issued overall [2:13-20]. It would have been obvious to one of ordinary skill at the time of the invention to have provided such a limit with that of Spector so that the provider of the coupons does not over-extend his offers.

Response To Arguments

Applicant argues that Spector describes objects of the invention, but does not include advertising research with respect to commercial messages and coupon activities. Spector is relied upon for specifics he teaches throughout the disclosure, not limited to what he summarily characterizes as object of the invention. Spector indeed teaches attaching to the coupon request, information about the commercial so that the commercial itself and the coupon activity resulting from it can be associated. ¶ 33 and claim 3 of Spector refer to a "specific commercial" and a correlation the time of coupon request with the broadcast time for that commercial for that specific product. Nonetheless, the examiner is not relying solely on Spector for the limitations related to analyzing coupon activities vs. specific commercials/programs.

Applicant argues that Landesmann lacks support in its provisional for interactive TV. Examiner has not researched this as it is moot until applicant successfully perfects the foreign priority. It is noted however that even if Landesmann merely disclosed a non-TV context, if such provision spoke to the different fee structures (coupon issuances and coupon redemptions), one of ordinary skill would find it obvious to use in any advertising context - including interactive TV.

Applicant argues that Kitsukawa does not lead to a further modification of Spector and Landesmann. Examiner has constructed a combination of prior art references, and provided a prima facie case of obviousness. Applicant has mainly addressed each reference singly rather than addressing the rejection as a whole and what it would represent to one of ordinary skill. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that certain capabilities “would be difficult” for the prior art. However it is noted that one of ordinary skill has a fair amount of skill in the contexts of the references – interactive TV broadcasting, telecommunications, programming, advertising, couponing, sales, etc. Even if a task were “difficult” does not necessarily make that task non-obvious, especially where there is motivation to do so.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee

pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/
Primary Examiner, Art Unit 3622

Jeffrey D. Carlson
Primary Examiner
Art Unit 3622